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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/924,783      | 08/07/2001  | Jacky G. Duchamp     | ACSC-60113          | 5784             |

24201 7590 03/24/2003

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EXAMINER

LAM, ANN Y

ART UNIT PAPER NUMBER

3763

DATE MAILED: 03/24/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

|                             |                        |                     |
|-----------------------------|------------------------|---------------------|
| <b>Offic Action Summary</b> | <b>Application N .</b> | <b>Applicant(s)</b> |
|                             | 09/924,783             | DUCHAMP, JACKY G.   |
|                             | <b>Examiner</b>        | <b>Art Unit</b>     |
|                             | Ann Y. Lam             | 3763                |

-- The MAILING DATE of this communication appars on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- THE MAILING DATE OF THIS COMMUNICATION.

  - Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  - Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1)  Responsive to communication(s) filed on 3/4/03

2a)  This action is FINAL.                    2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## **Disposition of Claims**

- 4)  Claim(s) 1-4 and 6-15 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) 1-4 and 6-14 is/are rejected.

7)  Claim(s) 15 is/are objected to.

8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

Application Papers

- 9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are: a)  accepted or b)  objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)  The proposed drawing correction filed on \_\_\_\_\_ is: a)  approved b)  disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)  The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)  All b)  Some \* c)  None of:

  1.  Certified copies of the priority documents have been received.
  2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14)  Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a)  The translation of the foreign language provisional application has been received.

15)  Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1)  Notice of References Cited (PTO-892)      4)  Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)      5)  Notice of Informal Patent Application (PTO-152)  
3)  Information Disclosure Statement(s) (PTO-1449) Paper No(s) 12.      6)  Other: \_\_\_\_\_

**DETAILED ACTION**

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4 and 11-14 are rejected under 35 U.S.C. 102(b) as being anticipated by Bazell et al., 3,884,242. Bazell et al. discloses a catheter shaft (2) having an inflation lumen (9), a guidewire receiving lumen (29) extending to a port (near 25) at the catheter shaft distal end and an inflation lumen (9), the guidewire receiving lumen (29) being in communication with a port (near 25); a balloon (16) having a proximal balloon shaft section adjacent the balloon proximal end, and a distal balloon shaft section adjacent the balloon distal end and being adhesively secured to the catheter, see column 7, lines 42-50, and column 10, lines 41-44; the balloon distal shaft section (45) having an outer surface tapering distally; and a tip member (19) on the distal end of the catheter and being in fluid communication with the catheter shaft guidewire receiving lumen, see Figure 3; the proximal end adhesively secured to the balloon distal shaft section, see column 8, lines 50-61, and the catheter shaft, see column 7, lines 64-67.

As to claim 2, the catheter shaft (2) extends distally beyond the balloon distal end, see Figure 7.

As to claim 3, the tip member proximal end forms a butt-joint with the balloon distal shaft section, see column 10, lines 35-37, and see column 12, lines 39-40.

As to claim 4, the tip member proximal ends (36) extends proximally over the distal end of the catheter shaft, see Figure 7.

As to claim 11, the adhesive for forming the adhesive seal between the balloon distal shaft section and the catheter shaft extends along the length of the balloon distal shaft section, see column 7, lines 42-50, and see reference number 17 and 17', in Figures 3 and 7.

As to claim 12, the adhesive is capable of being cured, see column 7, lines 64-67.

As to claims 13 and 14, Bazell et al. discloses the step of curing the adhesive to form the catheter assembly in column 7, lines 42-47.

Claim 10 is rejected under 35 U.S.C. 102(b) as being anticipated by Inoue, 5,100,386.

Inoue discloses a catheter shaft (10) having a guidewire receiving lumen (defined by inner tube 14) extending to a port (near 26) at the catheter shaft distal end and an inflation lumen (18); a balloon (16) having a proximal balloon shaft section adjacent the balloon proximal end, and a distal balloon shaft section adjacent the balloon distal end and being adhesively secured to the catheter shaft, see column 5, lines 16-18, and a tip member (24) on the distal end of the catheter and being in fluid communication with the catheter shaft guidewire receiving lumen, see Figure 1; the proximal end adhesively joined to the balloon distal shaft section, see column 3, lines 20-25.

*See col 3 l 36 - 40*

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 6-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bazell et al., 3,884,242.

Bazell et al. discloses the invention substantially as claimed. However, Bazell et al. does not disclose the length that the distal end of the catheter shaft extends distally beyond the balloon distal end, nor the length that the proximal end of the tip member extends distally over the catheter shaft as claimed by Applicant. However, Bazell et al. teaches that various modifications within the scope of the invention can be made by one of ordinary skill in the art without departing from the spirit thereof, see column 14, lines 5-8. It would have been obvious to one of ordinary skill in the art at the time the invention was made to make the Bazell et al. device with the various lengths as claimed by Applicant, as modifications that are within the scope of the invention as taught by Bazell et al.

***Response to Arguments***

Applicant's arguments filed September 23, 2002 have been fully considered but they are not persuasive. Applicant argues on page 3 that Bazell et al. does not disclose

the tip member being bonded to the catheter shaft and to the balloon distal shaft section, and that column 8, lines 50-61 of Bazell et al. states that the adhesive merely serves as fill material to provide a smooth transition and that only a bond with the cuff material needs to form. In response, Examiner reasserts that column 8, lines 50-61 clearly states that the tip can be secured to the body portion (2) as by adhesive, and that column 7, lines 64-67, discloses an adhesive between the tip and the balloon distal shaft section. Moreover, Bazell et al. merely discloses that the silicone rubber adhesive may not bond to the polyvinylchloride tip or polyvinylchloride portion (2), but will at least bond to the silicone member (12). Bazell et al. does not however teach that the adhesive bonds only to the silicone member (12). In fact, Bazell teaches that silicone rubber adhesives may bond to polyvinylchloride members, (see column 7, lines 42-51, where Bazell et al. teaches however that member (12) and inner member (2), which is made of polyvinylchloride, see column 5, lines 37-38, may be chemically bonded by using adhesive silicone rubber which may be heat-cured which are permanent under conditions of use.)

### ***Response to Arguments***

Applicant's arguments with respect to the above rejected claims have been considered but are not persuasive.

Applicant argues that Bazell et al. does not disclose that the distal tip (19) tapers distally from the proximal end thereof, see page 4 of Applicant's response. In response, Examiner asserts that Bazell discloses that distal tip (19), which includes portion (20),

see column 8, line 6, tapers distally from the proximal end thereof, see column 8, lines 6-8.

Applicant also argues that Bazell does not disclose that the balloon distal shaft section has a distally tapering outer surface, see page 5 of Applicant's response. Examiner asserts that Bazell discloses that the balloon distal shaft section (45) has a distally tapering outer surface.

As to claim 10, Applicant's argument is moot in view of the new rejection as described above.

#### ***Allowable Subject Matter***

Claim 15 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

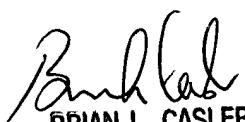
#### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ann Y. Lam whose telephone number is (703) 306-5560. The examiner can normally be reached on T-F 8-6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian L. Casler can be reached on (703)308-3552. The fax phone numbers for the organization where this application or proceeding is assigned are (703)305-3590 for regular communications and (703)306-4520 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0858.

A.L.  
March 30, 2003

  
BRIAN L. CASLER  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3700